

REMARKS

The Office Action mailed June 30, 2008, has been received and reviewed. Claims 1-28 are currently pending in the application. Claims 1-28 stand rejected. Applicant has amended no claims, and respectfully requests reconsideration of the application as presented herein.

Claim Rejections under 35 U.S.C. § 103

Claims 1-28 were rejected as being unpatentable over U.S. Pat. Pub. No. 2003/0017833 to Forrester (“Forrester”) in view of U.S. Patent 6,985,712 to Yamakawa *et al.* (“Yamakawa”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-28 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

Regarding independent claim 1 and claims 2-21 depending therefrom, independent claim 22 and claims 23 and 24 depending therefrom, independent claim 25 and claim 26 depending therefrom, and independent claims 27 and 28, Applicant’s independent claims include claim limitations not taught or suggested in the cited references.

The Office Action in the Response to Arguments section states:

The applicant argued that Forrester's system "never transmits and receives the same band over different antenna" (See Remark page 10). The examiner respectfully disagrees with the applicant's argument. ***The limitation "transmits and receives the same band over different antenna" is not recited in corresponding independent claims as argued.*** (Office Action, p. 6; emphasis added).

Applicant respectfully disagrees. In fact, Applicant's amendments in the previous amendment of May 29, 2008 added claim elements to this effect. Furthermore, the Office Action failed to consider Applicant's amendments of May 29, 2008 Amendment as clearly evidenced by the word-for-word reprinting of the Claim Rejections portion from the January 31, 2008 Office Action into the present Office Action, including claim elements no longer under examination since such elements were deleted from Applicant's claims in the May 29, 2008 Amendment.

Contrary to the Examiner's statement in the Response to Arguments section that "the limitation 'transmits and receives the same band over different antenna' is not recited in corresponding independent claims as argued,'" Applicant's independent claims 1, 22, 25, 27 and 28 clearly support Applicant's previous position and present position relating to the lack of teaching of such elements in the cited art. Specifically, Applicant's independent claims recite, *inter alia*:

1. A wireless device comprising: ...

a first section coupled to a first antenna ... for transmitting and receiving a first TDMA frequency band and for transmitting a second TDMA frequency band; and a second section coupled to a second antenna ... for receiving the second TDMA frequency band (Emphasis added.)

22. A device ... comprising:

a first section coupled to a first antenna ... for transmitting and receiving a first TDMA frequency band and for transmitting a second TDMA frequency band; and a second section coupled to a second antenna ... for receiving the second TDMA frequency band (Emphasis added.)

25. An apparatus comprising: ...

... transmit path for transmitting ... a second TDMA frequency band ...;
means for coupling ***the transmit path ... to a first antenna;***
... the second receive path ... for receiving the second TDMA frequency band; ...
means for coupling ***the second receive path ... to a second antenna....*** (Emphasis added.)

27. A wireless device comprising: ...

a first section coupled to a first antenna ... for transmitting and receiving a first TDMA frequency band and for transmitting a second TDMA frequency band; and a second section coupled to a second antenna ... for receiving the second TDMA frequency band. (Emphasis added.)

28. A method of operating a wireless device, comprising:
 ... *a transmit path for transmitting ... a second TDMA frequency band ... to a first antenna;* and
 ... *a second receive path ... to a second antenna,* and
 wherein *the second receive path ... is for receiving the second TDMA frequency band....* (Emphasis added.)

Applicant respectfully asserts that neither Forrester nor Yamakawa, either individually or in any proper combination, teach or suggest Applicant's invention as presently claimed in Applicant's independent claims. Generally, Forrester teaches transmitting and receiving a first cellular frequency band using a transmitter (Fig. 5, input to 270) and a first receiver (Fig. 5, beginning at 290) coupled to a "main antenna" (Fig. 5, 110) (e.g., first section/first antenna) and merely "scanning" (i.e., receiving) a second cellular frequency band using a second receiver (Fig. 5, beginning at 450) coupled to an "auxiliary antenna" (Fig. 5, 120a) (e.g., a second section/second antenna). In Forrester, when a second cellular frequency band as received on Forrester's second receiver (450) coupled to the auxiliary antenna (120a) is a "better" frequency band, then Forrester reconfigures the transmitter (input to 270) and a first receiver (beginning at 290) coupled to the "main antenna" (110) to transmit and receive the second cellular frequency band while reconfiguring the second receiver (beginning at 450) coupled to the "auxiliary antenna" (Fig. 5, 120a) to "scan" (i.e., receive) other frequency bands.

Specifically, Forrester teaches:

[0045] In an exemplary embodiment, the *main antenna system 240 gives priority to two-way communications* with a wireless communications network. However, *while the wireless communications device 100 is in two-way communications, the wireless communications device 100 can assign a lower priority to scanning other channels, bands or modes via the first auxiliary antenna 120a.* A scanning order for channels, bands or modes is determined by the main controller 210 via, for example, a list stored in a memory of the main controller 210. The scanning is achieved, for example, by the selector module 190 as controlled by the main controller 210. Decisions as to which channels, bands or modes to scan can also be determined in light of information received via the line or bus 230. *If the main controller 210 determines that there is a much better channel, band or mode available, the main controller 210 can switch the main antenna system 240 to the better channel, band or mode.* Such scanning can occur, for example,

at periodic intervals or as a function of a triggering condition such as, for example, reaching a threshold signal strength. (Emphasis added.)

Therefore, Forrester's system *never transmits and receives the same band over different antennas*. Accordingly, Forrester does not teach "*a first section coupled to a first antenna ... for transmitting and receiving a first TDMA frequency band and for transmitting a second TDMA frequency band; and a second section coupled to a second antenna ... for receiving the second TDMA frequency band*" as claimed, for example, in Applicant's independent claim 1. Applicant's other independent claims 22, 25, 27 and 28 include similar claim limitations.

The Office Action cites Yamakawa for merely suggesting "an antenna switch ... comprising a SP3T switch" (Office Action, p. 3).

Therefore, since neither Forrester nor Yamakawa teach or suggest Applicant's claimed invention, these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent claims 1, 22, 25, 27 and 28. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 22, 25, 27 and 28 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-21 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2-21 which depend therefrom.

The nonobviousness of independent claim 22 precludes a rejection of claims 23 and 24 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 22 and claims 23 and 24 which depend therefrom.

The nonobviousness of independent claim 25 precludes a rejection of claim 26 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 25 and claim 26 which depends therefrom.

Finality of Next Office Action Precluded

Applicant has traversed the rejection of claims 1-28 by argument and not amendment. Therefore, **the finality of the next office action would be improper** as Applicant is entitled to an examination on the merits and to amend as a matter of right. In the present Office Action, Applicant's independent claims 1, 22, 25, 27 and 28 were not completely examined as to **all** of the elements. Accordingly, Applicant submits that this omission to examine all elements of Applicant's claimed invention amounts to a failure to articulate a *prima facie* case of unpatentability and the burden to rebut this "rejection" has not yet shifted to the Applicant. Consequently, a next office action cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, presuming that such an office action sets forth a *prima facie* case. (MPEP § 706.07(a)).

CONCLUSION

Claims 1-28 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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